

### REMARKS

The Office Action altered an original election of species and then made it final. The final election of species is believed to be between:

I. Figs. 1A-B; 2, 3 A-C; 6A-B; 7A-B; 8 A-F; 9 A-B; 19 A-E; 20 A-C; 21 A-B; 22 A-E; 23 A-B; 24-27 A-C, said to correspond to claims 1-22, 24-56 and 71-78.

II. Figs 10 A-B; 11 A-C, said to correspond to claims 57-60.

III. Figs 4A-B; 5A-B; 12 A-B; 13A-B; 14 A-D and 15 A-D, said to correspond to claims 61-62.

IV. Figs 14 E-H said to correspond to claims 63-65.

V. Figs 16 A-B; 17 A-E and 18 said to correspond to claims 66-70.

The Office Action took the position that no claim was generic. Applicants herein object to the election of species requirement on several grounds. First, in reliance on the Office Action, applicants originally elected Group IV, which the Office Action said corresponded to claims 62-65. Since that has been changed in the most recent Office Action, applicants should be given the opportunity to elect a different species.

Second, the election is with traverse as the Office Action does not give deference to the written opinion of the PCT phase of this case. No election of species was required in the PCT Written Opinion. Applicants respectfully submit that the election of species requirement should be changed to a restriction requirement to be consistent with the treatment of the claims in the PCT Written Opinion.

Moreover, the election of species requirement is unduly burdensome on applicants and it would not be burdensome to search combinations of these species. For example, applicants respectfully submit that it would not be unduly burdensome to search group III along with group IV.

Applicants respectfully submit that at least one independent generic claim does exist in this case. Applicants note that a search of a reasonable number of species is warranted in such a case.

The Office Action rejected claims 63-65 under 35 U.S.C. Section 102 (b) based on Brunken, U.S. Pat. No. 5,683,415, McIntosh U.S. Pat. No. 5,693,072; Lewis U.S. Pat. No. 5,382,257, Prou U.S. Pat. No. 5,089,012 and Dery U.S. Pat. No. 3,394,704. All other claims were withdrawn from consideration.

U.S. Pat. No. 5,382,257 is directed to an implant assist apparatus for joining and/or reinforcing separated soft tissues in humans and animals. Representative tissues include muscles, tendons or ligaments (see column 1, lines 12-21). Notably absent is any mention of a sharp end adapted for boring through bone, as explicitly claimed in claim 63.

Lewis does disclose hard tissue (column 2, lines 52-53), however, Lewis fails to disclose a sharp end adapted for boring through bone. Lewis does disclose tunnels (column 1, line 60). The undersigned attorney believes that such tunnels are typically created by a drill not the sharp end of a tip that is associated with a thread.

Brunken, U.S. Pat. No. 5,683,415 discloses a needle 2, with a tip 6 and a dulled or colored area 10'. The Office Action took the position that the tip end 6 was adapted for boring bone. We respectfully disagree and note that the word "bone" does not appear in this patent. Additionally, the Office Action took the position that item 10 of Brunken was a "flexible extension", but reference character 10 refers to a portion of the needle that is dulled or colored (see column 2, line 28-32). Thus, Brunken clearly does not anticipate claim 63 as it fails to disclose each and every element of the claimed invention.

U.S. Pat. No. 3,394,704 to Dery discloses a surgical needle 7 with a point 8 and a thread 6. There is no disclosure of a "flexible extension of said tip, opposite of said sharp end and substantially longer than said sharp tip," as explicitly claimed in claim 63. Again, Dery fails to anticipate claim 63 as well.

Prou, U.S. Pat. No. 5,089,012 discloses a needle 1, a monofilament 2 and an intermediate element 3. The tip is triangular. The tip is not adapted for being grasped by a nonsolid needle, at a side of the extension, as explicitly claimed in claim 63. Thus, Prou does not disclose all of the elements of claim 63, thus the rejection should be withdrawn. Similarly, Prou fails to disclose all of the limitations of independent claim 65 as well.

McIntosh, U.S. Pat. No. 5,693,072 discloses a blunt tip surgical needle. The needle has a blunt head 16 which is configured to permit piercing of muscle and fascia, muscle alone, adipose, pericostal tissue and other non-cutaneous soft tissue (see column 9, lines 27-

33). The needle fails to disclose the "flexible extension of the tip" as set forth in original claim 63, nor does it disclose the elements added to claims 63 and 65. Thus, the anticipation rejection based on McIntosh should be withdrawn as well.

A fee of \$86.00 is believed due for the submission of one extra independent claim. Please charge this fee to Deposit Account No. 501921. No other fee is believed due for the submission of this response. If this is in error, applicants respectfully request and petition that any fee required for the timely submission of this response be charged to Deposit Account No. 501921.

A Supplemental Information Disclosure Statement was mailed in this case on November 6, 2003. Applicants respectfully request that the Supplemental Information Disclosure Statement be considered and acknowledged in the next Official Action.

If the Examiner believes a teleconference would be useful or helpful in progressing prosecution of this case, the Examiner is invited to telephone the undersigned attorney at 952-930-6135.

Registration Number 34,109	Telephone Number 952 930-6135
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Respectfully submitted,

By

  
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